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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,502	09/11/2000	Monica R. Nassif	497.001US1	4893
7590 04/10/2008 Mark A Litman & Associates P A York Business Center Suite 205 3209 West 76th Street Edina, MN 55435				
EXAMINER HUI, SAN MING R				
ART UNIT 1617		PAPER NUMBER		
MAIL DATE 04/10/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/659,502

**Applicant(s)**

NASSIF ET AL.

**Examiner**

San-ming Hui

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31, 33-37, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31, 33-37, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Applicant's amendments filed January 18, 2008 have been entered. The claims are now directed to a solution composition. Since WO98/21307 is directed to a microemulsion composition and not a solution composition, the outstanding rejection under 35 USC 103 (a) is withdrawn. In view of the terminal disclaimer filed January 18, 2008, the outstanding double patenting rejection is withdrawn.

New ground of rejection is set forth below:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31, 33-35, 37, and 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 31, 33-35, 37, and 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: an agent that will make the herein claimed liquid composition to become solution. The examiner notes that in claim 31, the broadest claim, recites a liquid solution composition comprising up to 20% of essential oil, a solvent such as water or alcohol. If water is the only solvent present, the resulting composition cannot be a solution because essential oils are not miscible with water. It is further not clear how the composition of the instant invention with an essential oil, water, and a surfactant (for

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example in claim 33) becomes a solution composition. With two phases present in the liquid composition in combination with a surfactant, it is natural for the composition to become an emulsion – either oil-in-water or water-in-oil types emulsion, or some forms of dispersion. It is not clear how components in the claims as now recited gives rise to a solution.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 31, 33-37, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,403,587 ('587, reference of record) in view of Remington's Pharmaceutical Science, 18<sup>th</sup> ed., 1990 page 1308, 1312, and 1314. Page 1314 of Remington was provided along with the previous office action mailed September 18, 2007.

'587 teaches a method of disinfecting hard surface with aqueous essential oils composition comprising alcohol, water, 0.75 – 1.0% of surfactant, and 0.2 weight percent of essential oil (See col.2, lines 20-24 and col. 3, lines 29-37). '587 also teaches the pH of the composition as 1-12 (See col. 4, lines 45-47). '587 also teaches the composition as useful to clean and disinfect hard surfaces such as countertops, tiles, etc. (See col. 6, lines 12-16).

'587 does not expressly teach the herein recited ranges of essential oil and long chain aliphatic alcohol. '298 does not expressly teach the surfactant as Tween 20, stearyl alcohol, or cetyl alcohol. '587 does not expressly teach the pH as 6.5-7.0.

Remington teaches that Tweens (polysorbate) as commonly use nonionic surfactant in pharmaceutical, cosmetics (See page 1314). Remington also teaches that stearyl alcohol and cetyl alcohol as commonly used surfactants useful in cosmetics or pharmaceuticals (See pages 1308 and 1312).

It would have been obvious to one of ordinary skill in the art at the time of invention to employ the herein claimed concentration of essential oil and long chain aliphatic alcohol in the cleaning composition and the disinfecting method. It would have been obvious to one of ordinary skill in the art at the time of invention to employ the herein claimed pH in the cleaning composition and the disinfecting method. It would have been obvious to one of ordinary skill in the art at the time of invention to employ a nonionic surfactant Tween 20, stearyl alcohol, or cetyl alcohol, in the herein claimed dosage, in the cleaning composition and the disinfecting method.

One of ordinary skill in the art would have been motivated to employ the herein claimed concentration of essential oil and long chain aliphatic alcohol as well as the herein claimed pH of the composition in the cleaning composition and the disinfecting method. Since the concentration of essential oil and long chain aliphatic alcohol as well as the pH of the cleaning composition of '587 are overlapped with those of herein claimed, the optimization of these parameters would be considered obvious as being within the purview of skilled artisan, absent evidence with regard to the criticality of the herein claimed ranges.

One of ordinary skill in the art would have been motivated to employ a nonionic surfactant Tween 20, stearyl alcohol, or cetyl alcohol, in the herein claimed dosage, in the cleaning composition and the disinfecting method. It is known that various surfactants as useful in the composition of '587. Therefore, employing any well-known pharmaceutically and cosmetically acceptable surfactant, including Tween 20, stearyl alcohol, or cetyl alcohol, would be considered simply employing obvious alternatives, absent evidence to the criticality of employing Tween 20, stearyl alcohol, or cetyl alcohol, in the instant invention.

### ***Response to Arguments***

Applicant's arguments filed January 18, 2008 averring the cited prior art's failure to teach a solution composition have been fully considered but they are moot in view of the new ground of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (571) 272-0626. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

San-ming Hui  
Primary Examiner  
Art Unit 1617

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